UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,758	03/26/2004	Benjamin N. Eldridge	P127C1-US	9082

27520	7590	08/09/2004	

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EXAMINER
BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/810,758	ELDRIDGE ET AL.
	Examiner	Art Unit
	Bradley Bayat	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _26 March 2004_.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _54-63_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _54-63_ is/are rejected.

7) ☒ Claim(s) _54-63_ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims 1-24 have been canceled and new claims 54-63 have been added as per

applicant's preliminary amendment dated March 26, 2004. Thus, new claims 54-63 are

presented for examination on the merits.

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly

    indicative of the invention to which the claims are directed. The following title is

    suggested: An automated system for designing and testing a probe card.

2. The examiner suggests that the applicant make a specific reference to the prior

    application(s) in the first sentence of the specification, even though it appears that the

    applicant has made a reference in the application data sheet (37 CFR 1.78(a)(2) and

    (a)(5)). The specific reference to any prior nonprovisional application must include the

    relationship (i.e., continuation, divisional, or continuation-in-part) between the

    applications except when the reference is to a prior application of a CPA assigned the

    same application number.

Claim Objections

Claims 54-63 are objected to because of the following informalities:

1. Applicant's wording of the claims can be read to denote that the applicant is claiming

    a probe card. Instead, the applicant appears to be claiming an automated system. For

    example, "An automated system for enabling a customer to design a probe card, said

system comprising: a server coupled to a network... Therefore, the dependent claims

would follow "The system of claim..."

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the

original numbering of the claims to be preserved throughout the prosecution. When

claims are canceled, the remaining claims must not be renumbered. When new

claims are presented, they must be numbered consecutively beginning with the

number next following the highest numbered claims previously presented (whether

entered or not). Applicant's original claims were numbered 1-24 and upon canceling

those claims in the preliminary amendment dated March 26, 2004, the applicant

added new claims beginning with claim 54. The next new claim should have been

numbered claim 25.

3. Appropriate correction is suggested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

Claims 54-55 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Applicant's claims recite the following limitations, however, there is insufficient

antecedent basis for these limitations in the claim:

- "said prospective customer" line 5 of claim 54.

- "said prospective customer" line 9 of claim 54.

- "the acceptability" line 10 of claim 54.

- "the input" line 3 of claim 55.

The examiner recommends that the applicant review each claim to ensure that all claim

limitations are sufficiently supported and particularly point out and distinctly claim the subject

matter that the applicant regards as the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 54-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooke, et

al. (hereinafter Cooke), U.S. Patent 6,701,474 B2.

<u>As per the following claims, Cooke discloses:</u>

Claim 54 (New): A probe card designed by an automated system, said system

comprising: a server connectable to a network, an application operable with said server to

provide functions comprising: receiving over said network from said prospective customer

information describing a wafer to be tested, generating from said information-a verification

package comprising a proposed design of said probe card for testing said wafer; and

communicating over said network with said prospective customer regarding the acceptability of

said proposed probe card design (figures 1-4 and associated text).

Claim 55 (New): The probe card of Claim 54, wherein said application further provides

the function of providing a graphical interface for use by said prospective customer to enable the

input of said information describing a wafer to be tested (column 5, lines 1-8).

Claim 56 (New): The probe card of Claim 55, wherein said graphical interface further

comprises at least one Web page (column 8).

Claim 57 (New): The probe card of Claim 54, wherein said application further provides

the function of accepting an order from said prospective customer to manufacture said proposed

probe card design (figure 4 and associated text).

Claim 58 (New): The probe card of Claim 54, wherein said application further provides

the function of verifying said proposed probe card design (figures 4,5 and associated text).

Claim 59 (New): The probe card of Claim 54, wherein said verification package further

comprises drawings of said proposed probe card design (figures 6,7 and associated text).

Claim 60 (New): The probe card of Claim 54, wherein said communicating function further comprises notifying said prospective customer of proposed modifications to said proposed probe card design (column 17, line 57-column 18, line 23).

Claim 61 (New): The probe card of Claim 58, wherein said verifying function further comprises simulating operation of said proposed probe card design (column 1, lines 13-34).

Claim 62 (New): The probe card of Claim 58, wherein said verifying function further comprises performing an automated simulation of said proposed probe card design.

Claim 63 (New): The system of Claim 58, wherein said verifying function further comprises performing a simulation based on particular specifications designated by said prospective customer (column 6, lines 40-51).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.
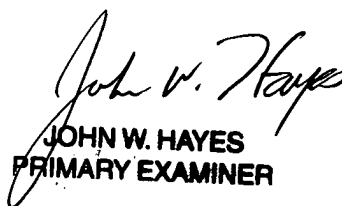
Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The

examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbb

JOHN W. HAYES
PRIMARY EXAMINER